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PPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,594	11/19/2003	Paul Meller	5552.1437-01	8652
22852 75	90 04/01/2005		EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	
			DATE MAILED: 04/01/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief

Application No.	Applicant(s)
10/717,594	MELLER, PAUL
Examiner	Art Unit
Richard A. Rosenberger	2877

(61)

		Richard A. Rosenberger	2877	
	The MAILING DATE of this communication appe	ears on the cover sheet with the	correspondence add	ress
THE RE	• •	APPLICATION IN CONDITION FO	·	
1. ⊠ T a _l a _l R tii	he reply was filed after a final rejection, but prior to filing oplicant must timely file one of the following replies: (1) oplication in condition for allowance; (2) a Notice of Applequest for Continued Examination (RCE) in compliance periods:	g a Notice of Appeal. To avoid aba an amendment, affidavit, or other peal (with appeal fee) in compliance with 37 CFR 1.114. The reply mu	indonment of this app evidence, which plac e with 37 CFR 41.31;	es the or (3) a
a) 🔀 b) 🗀	The period for reply expires 3 months from the mailing date of the period for reply expires on: (1) the mailing date of this Advevent, however, will the statutory period for reply expire later the Examiner Note: If box 1 is checked, check either box (a) or (b) MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f	risory Action, or (2) the date set forth in the an SIX MONTHS from the mailing date on ONLY CHECK BOX (b) WHEN THE F	of the final rejection.	
peen file CFR 1.1 above, if earned p	ns of time may be obtained under 37 CFR 1.136(a). The date on d is the date for purposes of determining the period of extension a 7(a) is calculated from: (1) the expiration date of the shortened standard checked. Any reply received by the Office later than three month atent term adjustment. See 37 CFR 1.704(b).	and the corresponding amount of the fee. atutory period for reply originally set in the	The appropriate extension final Office action; or (2)	on fee under 37 as set forth in (b)
W A A	ne reply was filed after the date of filing a Notice of App as filed on A brief in compliance with 37 CFR 4 ppeal (37 CFR 41.37(a)), or any extension thereof (37 of ppeal has been filed, any reply must be filed within the DMENTS	41.37 must be filed within two mon CFR 41.37(e)), to avoid dismissal	ths of the date of filing of the appeal. Since a	the Notice of
3. 🔲 1	The proposed amendment(s) filed after a final rejection, They raise new issues that would require further co			because
(b	They raise the issue of new matter (see NOTE below) They are not deemed to place the application in be appeal; and/or	ow);	•	the issues for
(0) They present additional claims without canceling a NOTE: <u>see attached note</u> . (See 37 CFR 1.116 ar	· · ·	ejected claims.	
	The amendments are not in compliance with 37 CFR 1.	121. See attached Notice of Non-C	compliant Amendment	: (PTOL-324).
6. 🔲 1	Newly proposed or amended claim(s) would be a e non-allowable claim(s).		e, timely filed amendn	nent canceling
ho Ti	or purposes of appeal, the proposed amendment(s): a) bw the new or amended claims would be rejected is pro- ne status of the claim(s) is (or will be) as follows:		vill be entered and an	explanation of
С	laim(s) allowed: laim(s) objected to: laim(s) rejected: <u>35-59</u> .			
	laim(s) withdrawn from consideration: NIT OR OTHER EVIDENCE			
3. 🔲 T	he affidavit or other evidence filed after a final action, because applicant failed to provide a showing of good ar nd was not earlier presented. See 37 CFR 1.116(e).			
er st	he affidavit or other evidence filed after the date of filing attered because the affidavit or other evidence failed to a nowing a good and sufficient reasons why it is necessa	overcome <u>all</u> rejections under apperry and was not earlier presented.	eal and/or appellant fa See 37 CFR 41.33(d)(ils to provide a 1).
REQUE	The affidavit or other evidence is entered. An explanation is FOR RECONSIDERATION/OTHER		•	
	The request for reconsideration has been considered by	,		ince because:
	Note the attached Information Disclosure Statement(s). Other:	. (PTO/SB/08 or PTO-1449) Paper	No(s)	
				•

- 1. The amendment filed 14 March 2005 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because the proposed amendment raises new issues that would require further consideration and/or search.
- The proposed amendment filed 14 March 2005 adds to independent claims 35, 54 and 57 the subject matter previously presented in claim 36, dependent from claim 35, and considered in the final rejection, with claim 36 now proposed to be cancelled. Thus claim 35, as it is proposed, appears to be of the same scope as claim 36 as treated in the final rejection. However, claims 35 and 36 were not the only claims previously presented and considered, and not all of the claims other than claim 35 claimed the material of claim 36. Thus at least proposed claims 47-50 and 54-59 (including proposed independent claims 54 and 57) are of a different scope than claims previously presented and considered), and further consideration and/or search would be required for at least these claims.
- 3. Further, it is not clear that the proposed amendments and arguments would overcome the rejection; claim 36 was previously rejected.

The remarks filed 14 March 2005 purport to traverse "what is allegedly 'well known in the art" (remarks, page 10, lines 20-21), partially quoting the statement of the final rejection (page 5, lines 1-7 of the statement of the final rejection). It is noted that the quoted part of the statement of the final rejection ends prematurely, giving the false impression that the rejection is based upon official notice that "appropriate diaphragms and beam directing mirrors can be used to separate scattered and transmitted light". However, statement of the rejection does not in fact

Art Unit: 2877

end where the remarks truncate it, and goes on to point to teaching in three co-cited references to demonstrate that this observation of the state of the art is correct. Thus it is not clear what is in fact being "traversed"; the references referred to for demonstrating this fact are all well within the timeframes to make them applicable under 35 USC 102(b), and thus are, in fact, prior art, and what they teach is therefore, in fact, known in the art.

The remarks argue that the reference to Tucker somehow "teaches away" from using the diaphragm of claim 36. While it is true that Tucker does not use a diaphragm as claimed in claim 36, the fact that Tucker uses an alternative manner of separating the scattered and directly transmitted light does not remove the use of diaphragms for this purpose, as shown by other cited and applied references, from the art, nor would those in the art, reading Tucker, forget that diaphragms can, and have been, used for this purpose in the art, nor would they mistakenly come to believe that, despite the evidence in the art that such separation arrangements can work, and have worked, that they would not work.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A Rosenberger whose telephone number is (571) 272-2428. The examiner can normally be reached on Monday through Friday during the hours of 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (tol-free).

R. A. Rosenberger 30 March 2005

Richard A. Rosenberger Primary Examiner